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09/815,934	03/23/2001	Matthew J. Murnaghan	034300-145	8244

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EXAMINER

LELE, TANMAY S

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 04/27/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/815,934

**Applicant(s)**

MURNAGHAN ET AL.

**Examiner**

Tanmay S Lele

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 09 February 2004 for claims 1, 2, 5, 7, 8, 22, 29, and 30 have been fully considered but they are not persuasive.

In regards to claim 1, Applicant requests a copy of the Provisional Application 60/230,084 to ascertain if support for the cited sections exist and thus a copy of the provisional application has been provided. After review by Examiner, it was respectfully believed that support was contained in this application and in its figures.

In further regards to claim 1, Applicant further states, "Figures 2, 4, and 5 do not provide indication that the charging of the units happens simultaneously." Note that in regards to these figures, paragraph 0043 states that both batteries are charged when the charger is connected. Note that 60/230,084 provides support for this (as per Figure 8 and page 3 where support and specific reference to simultaneously can be found).

In further regards to claim 1, Applicant continues, "Accordingly, the Janik application should be read as actually teaching away from the claimed invention. This is particularly evident when reading the entirety of paragraph 0044, where the disclosure specifically points out the problems associated with simultaneous recharging, and includes specialized circuitry for "begin[ning] to charg[e] the other battery." Note that upon review of the provisional application 60/230,084, no indication of the feature and functionality noted in paragraph 0044 was made and hence it is believed that the matter in question, not being supported by 60/230,084, is not entitled to the priority date. Hence it is respectfully submitted that Applicant's arguments are moot as this

matter would not be proper as it is not entitled to the provisional date and hence not valid under 102 (e).

2. In response to applicant's argument that "...it should be apparent that the Janik device has no clips that engage the personal data assistant," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In regards to claim 22, Applicant attempts to overcome the rejection by stating, "Turning to the Janik reference, it should be apparent that the Janik device has no clips that engage the personal data assistant." Examiner respectfully disagrees with Applicant. Note that Janik states the connector provides both electrical and mechanical connect (for example paragraph 0032) and in addition to the cited passage (0034). Note additionally a latch, by definition is "any of various devices in which mating mechanical parts engage to fasten but usually not to lock something where by definition," as defined by Merriam-Webster's 10<sup>th</sup> Edition Dictionary. Hence, because the Examiner is required to interpret the claims in the broadest reasonable manner under current examining practice, the Examiner is not persuaded by the Applicant's arguments suggesting that the references do not teach or recite the claimed as broadly interpreted.

3. Applicant's arguments with respect to claims 4, 27, 3, 6, 23 – 26, 28, and 9 – 21 have been considered but are moot in view of the new ground(s) of rejection.

***Specification***

4. The use of the trademarks SONY, CLIE, PALM, and AIRCARD300 have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5 – 26, and 28 – 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Janik et al. (Janik, US Patent No. 2002/0078248).

Regarding claim 1, Janik teaches of a wireless communication device for allowing wireless communication for a personal data assistant coupled with the wireless communication device (Figures 2 – 5), the wireless communication device comprising: a modem for providing wireless communication capability to the wireless communication device (Figures 2 – 7 and paragraphs 0027, 0036, and 0037); and a pass-through serial connector configured to allow simultaneous charging of the wireless communication device and the personal data assistant, the configuration of the pass-through serial connector also allowing interfacing between the wireless

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communication device and a peripheral device (Figures 2, 4, and 5 and paragraphs 0033, 0039, and 0040).

Regarding claim 22, Janik teaches of a wireless communication device for providing wireless communication to a personal data assistant, the wireless communication device being configured to hold the personal data assistant (Figures 2 – 5), the wireless communication device comprising: a first end, the first end including a serial port connector, the serial port connector being configured to engage with a serial port connector of the personal data assistant such that the wireless communication device serial port connector couples with the personal data assistant serial port connector in order to provide connectivity between the wireless communication device and the personal data assistant (Figures 2 – 5 and paragraphs 0027, 0033, 0034 and 0039); and a top housing, the top housing having clips opposite the first end of the wireless communication device, the clips being configured to engage the personal data assistant with the wireless communication device (Figures 2, 5 and 9 and paragraph 0034).

Regarding claim 2, Janik teaches all the claimed limitations as recited in claim 1. Janik further teaches of wherein the peripheral device is a portable keyboard (Figures 2 – 8 and paragraph 0039).

Regarding claims 5 and 29, Janik teaches all the claimed limitations as recited in claim 1. Janik further teaches of wherein the wireless communication device may be reconfigured for different personal data assistants (paragraph 0028).

Regarding claims 6 and 28, Janik teaches all the claimed limitations as recited in claims 1 and 22. Janik further teaches of the wireless communication further comprising: custom interface circuitry having a battery charger input, the battery charger input having inputs

connected in parallel in order to allow the simultaneous charging of both the wireless communication device and the personal data assistant (paragraph 0043).

Regarding claim 7, Janik teaches all the claimed limitations as recited in claim 1. Janik further teaches of wherein the wireless communication device further comprising: a top housing configured to hold the personal data assistant (Figures 2, 3, 5, 6, 7, and 9).

Regarding claim 8, Janik teaches all the claimed limitations as recited in claim 7. Janik further teaches of wherein the top housing includes clips which hold the personal data assistant when the personal data assistant couples with the wireless communication device (Figure 2 and 9 and paragraph 0034).

Regarding claim 9, Janik teaches of a wireless communication device for providing wireless communication to a personal data assistant (Figures 2 – 5), the device comprising: a modem which provides wireless communication capability to both the wireless communication device and the personal data assistant (Figures 2 – 5 paragraphs 0027, 0036, and 0037); an external serial connector which allows simultaneous charging of the wireless communication device and personal data assistant (Figures 2 – 7 and 9 and paragraphs 0033 and 0043) where the external serial connector provides connectivity between a peripheral device and both the wireless communication device and the personal data assistant such that the peripheral device uses the modem of the wireless communication device (Figures 2 – 7 and paragraph 039).

Regarding claim 10, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of the wireless communication device further comprising: a top housing which holds the personal data assistant with the wireless communication device (Figures 2, 3, 5, 6, 7, and 9).

Regarding claim 11, Janik teaches all the claimed limitations as recited in claim 10. Janik further teaches of wherein the top housing includes clips configured to hold the personal data assistant with the wireless communication device (Figure 2 and 9 and paragraph 0034).

Regarding claim 12, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of wherein the external serial connector includes a battery charger input having inputs connected in a parallel configuration, where the parallel configuration of the inputs allows the simultaneous charging of the wireless communication device and the personal data assistant (paragraph 0043).

Regarding claim 13, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of wherein the external serial connector is a serial port connector (paragraphs 0039 and 0043).

Regarding claim 14, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of wherein the peripheral device is a portable keyboard (paragraph 0039).

Regarding claim 15, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of wherein the top housing further includes: clips coupled with the top housing, the clips being configured to hold the personal data assistant with the wireless communication device (Figure 2 and 9 and paragraph 0034).

Regarding claim 16, Janik teaches all the claimed limitations as recited in claim 9. Janik further teaches of wherein the external serial connector allows connectivity between the wireless communication device and the personal data assistant during hot-syncing of the personal data assistant (Figure 9 and paragraph 0033 and 0039).



Regarding claim 17, Janik teaches of a communication device for providing wireless communication for a personal data assistant (Figures 2 – 5), the device comprising: a connector for providing connectivity between the communication device and the personal data assistant (Figures 2 – 7); a modem for providing communication capability to the communication device such that the modem provides communication capability for the personal data assistant (Figures 2 – 5 paragraphs 0027, 0036, and 0037); and a pass-through serial connector for allowing the simultaneous charging of both the communication device and the personal data assistant (Figures 2 – 7 and 9 and paragraphs 0033 and 0043), the pass-through serial connector also providing connectivity to both the communication device and the personal data assistant with a peripheral device (Figures 2 – 7 and paragraph 039).

Regarding claim 18, Janik teaches all the claimed limitations as recited in claim 17. Janik further teaches of wherein the communication device holds the personal data assistant with clips (Figure 2 and 9 and paragraph 0034).

Regarding claim 19, Janik teaches all the claimed limitations as recited in claim 17. Janik further teaches of wherein the peripheral device is a portable keyboard (paragraph 0039).

Regarding claim 20, Janik teaches all the claimed limitations as recited in claim 17. Janik further teaches of wherein the communication device further comprises: custom interface circuitry having a micro controller (paragraphs 0041 and 0042).

Regarding claim 21, Janik teaches all the claimed limitations as recited in claim 17. Janik further teaches of wherein the micro controller is configured to buffer data received from the peripheral device via the pass-through serial connector such that the configuration of the

micro controller allows sharing of data between the communication device and personal data assistant (paragraphs 0041 and 0042).

Regarding claim 23, Janik teaches all the claimed limitations as recited in claim 22. Janik further teaches of the wireless communication device further comprising: a pass-through serial connector configured to allow simultaneous charging of the wireless communication device and the personal data assistant (paragraph 0043).

Regarding claim 24, Janik teaches all the claimed limitations as recited in claim 23. Janik further teaches of wherein the pass-through serial connector provides connectivity between the wireless communication device and a peripheral device (paragraph 0039 and 0043).

Regarding claim 25, Janik teaches all the claimed limitations as recited in claim 23. Janik further teaches of wherein the pass-through serial connector provides connectivity between the personal data assistant and a peripheral device (paragraph 0039).

Regarding claim 26 Janik teaches all the claimed limitations as recited in claim 23. Janik further teaches of wherein the pass-through serial connector allows hot-syncing of the personal data assistant when the personal data assistant is coupled with the wireless communication device (paragraph 0033 and 0039).

Regarding claim 30, Janik teaches all the claimed limitations as recited in claim 22. Janik further teaches of wherein the wireless communication device serial port connector provides hand-shaking capability (Figure 9 and paragraphs 0033 and 0039).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik et al. (Janik, US Patent No. 2002/0078248) as applied to claims 1 and 22 above.

Regarding claims 4 and 27, Janik teaches all the claimed limitations as recited in claims 1 and 22. Janik further teaches of PDA being any number type of PDA not limited to PALM (paragraph 0028) but not specifically of wherein the personal data assistant is a SONY CLIE personal data assistant.

It would have been obvious to one skilled in the art at the time of invention to have included in Janik's universal PDA modem, the SONY CLIE, for the purposes of interoperability with other PDA's such as the SONY CLIE (stated to be a PDA in Applicant's background), as taught by Janik.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janik et al. (Janik, US Patent No. 2002/0078248) as applied to claim 1 above, in further view of Raff et al. (Raff, US Patent No. 6,611,849).

Regarding claim 3, Janik teaches all the claimed limitations as recited in claim 1. Janik further teaches of wherein the pass-through serial connector allows charging of the wireless communication device (paragraph 0043) and hot-syncing of the personal data assistant (paragraph 0039).

Janik does not specifically state the two occur simultaneously.

In a related art dealing with PDA synchronization Raff teaches of the two occur simultaneously (column 3, lines 1 -12).

It would have been obvious to one skilled in the art at the time of invention to have included into Janik's PDA/modem combination, Raff's synchronization techniques, for the purposes of synchronization of multiple devices without connecting all at once and further ease of synchronization, as taught by Raff.

10. Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janik et al. (Janik, US Patent No. 2002/0078248) as applied to claims 1 and 9 above, in further view of Coulon et al. (Coulon, US Patent No. 5,712,760).

In regards to claims 2 and 14, Janik teaches all the claimed limitations as recited in claims 1 and 9. Janik does not specifically state wherein the peripheral device is a portable keyboard (though does make reference to input devices).

In a related art dealing with personal data assistants, Colon teaches of a wherein the peripheral device is a portable keyboard (column 2, lines 12 -25).

It would have been obvious to one skilled in the art at the time of invention to have included into Janik's PDA/Modem combination, Coulon's keyboard peripheral, for the purposes of ease in data entry with a known medium, as taught by Coulon.

***Citation of Pertinent Prior Art***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Inventor	Publication	Number	Disclosure
Jaggers et al.	US Patent Application	2002/0119800	Docking Station for Wireless Communication Device
Gudgel et al.	US Patent Application	2002/0058538	Wireless Communications Backpack for a Portable Device
Murnaghan et al.	US Patent Application	2002/0107042	Handheld Wireless Communications Device

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Register et al.	US Patent	5,606,594	Communication accessory and method of telecommunicating for a PDA
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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday – Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

  
Tanmay S Lele  
Examiner  
Art Unit 2684

tsl  
April 20, 2004

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER